

REMARKS

This paper is submitted in reply to the Office Action dated November 3, 2006 within the three-month period for response.

In the subject Office action, claims 1-15 were examined. In response thereto, claims 1, 2, 4 and 6 are amended, and claims 3, 5 and 7-15 remain under active prosecution. Applicants assert that the claims are supported by the Specification as originally filed and do not introduce new subject matter.

In the subject Office Action, claims 8-9 were rejected under 35 U.S.C. § 112 ¶ 1 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The subject Office Action based that rejection on the assertion that “there is no previous mention of a ‘vector equation,’” a term which appears in claims 8 and 9. In response to that assertion, applicants note that lines 14-15 of page 9 of the specification as originally filed explicitly teaches the use of vector equations for use in creating diagrams in the context of an architectural contract document. Therefore, applicants traverse the assertion that there is no previous mention of a “vector equation” in the pending application, and request that the rejections of claims 8 and 9 under 35 U.S.C. § 112 ¶ 1 be withdrawn.

Turning to the art-based rejections, the subject Office Action rejected each pending claim as unpatentable over U.S. 6,446,053 (“Eliot”). Applicants traverse, and request that each such rejection be withdrawn and that the pending claims be allowed in their present form.

Initially, applicants appreciate the Examiner’s response to the request that the Examiner “address each limitation in the pending claims.” However, there are many limitations for which applicants were unable to find a treatment in the subject office action. For example, the first clause after the preamble of claim 7 recites

maintaining an association between each of a plurality of pieces of selectable design information for a building and a respective data entry location in one or more of the schedule aspect and the specification aspect;

However, the subject Office Action addressed the limitations of that clause by stating only that “Elliot discloses maintaining an association between a plurality of pieces of selectable, design information (28, fig 1),” which, even if it is an accurate characterization of Elliot, does not say what the association is with. Indeed, applicants note that component 28 of figure 1 is a box labeled “Databases” that contains four smaller boxes labeled “Catalog,” “Contractor,” “Regional,” and “Plan.” Thus, to the extent that component 28 of Figure 1 discloses associations between anything, those associations are between different databases, not between pieces of selectable design information and respective data entry locations in a schedule aspect and/or a specification aspect of a contract document.

Similar omissions also occur in the treatment of the other claims (e.g., clause 2 of claim 1 which recites “at least one attribute information storage means, comprising a database from which a user-selected attribute is identified, each attribute having a unique identifier and data associated with it;” was addressed by the statement that Elliot teaches “an attribute storage means (databases at 28, as best seen in Figure 1).”). Thus, it is difficult for applicants to present arguments demonstrating how the individual limitations in the pending claims distinguish those claims from the prior art.

While the treatment of the pending claims makes it difficult for applicants to present arguments relating to patentability, in an effort to reach an agreement with the Examiner, applicants have made amendments so that each of the pending independent claims (claims 1, 2, 4, 6 and 7) recite a system or method for creating a plurality of aspects of a contract document, and that those aspects comprise at least a specification and a schedule. Applicants assert that those limitations are not taught or suggested in Elliot because Elliot is designed to be a “tool that enables owners to accomplish the tasks usually performed by a general contractor” (col. 2, ll. 18-20) while the invention as claimed automates the creation of a “contract document” which is a specific type of document created through the collaboration of architects and engineers (*see* page 3 of the application as originally filed), not by general contractors. Consequently, the specification and schedule recited in the pending claims (defined on page 2 of the application as originally filed) which are particular aspects of the contract document, are not taught or suggested in Elliot. Therefore, applicants submit that the pending claims recite limitations which are not

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taught or suggested in Elliot. Consequently, the rejections of those claims should be withdrawn, and the claims should be allowed.

General Remarks

Applicants note that the Examiner stated, on page 7 of the subject office action, that the subject office action was being issued as a non-final action. In light of that statement, applicants are confused by the Office Action Summary, which states that the subject office action *is* a final action. Following the Examiner's statement on page 7 of the subject office action, applicants have framed this response as a response to a non-final action. To the extent that the subject office action is treated as a final action, applicants request that the amendments to the claims be entered, and the arguments set forth herein be considered, as no new matter is believed or intended to be introduced by those amendments, and applicants have made their arguments in good faith reliance on the Examiner's statement.

Applicants submit that the above discussion does not constitute an exhaustive list of the novel limitations found in claims 1-15 which are not taught or suggested in the prior art of record. To the extent that applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, applicants reserve all rights with respect to arguments not explicitly raised herein.

Conclusion

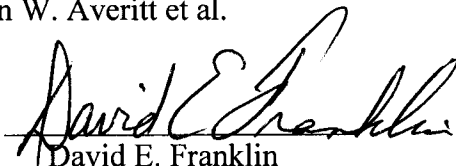
In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, David Franklin at (513) 651-6856 or dfranklin@fbtlaw.com.

Although no new fees are due, the Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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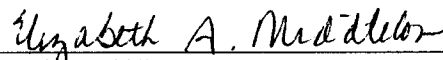


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